

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-7, 10-23, and 26 are presently pending. Applicant amends Claims 1-4, 6-7, 10-11, 16-17, 19, 22-23, and 26 herein. No claims are withdrawn, canceled, or added herein.

### **Statement of Substance of Interview**

**[0004]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on 07/30/08. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, I discussed how the claims differed from the cited references, but primarily Fenwick. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0006]** The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the proposed clarifying claim amendments appeared to distinguish over the cited art of record. For example, the Examiner indicated that clarification regarding using a hash distinguished claim 17 over the cited art. However, the Examiner indicated that he would need to review the cited art more carefully and do another search, and requested that the proposed amendments be presented in writing and submitted with an RCE.

**[0007]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited references of record for at least the reasons discussed during the interview.

### **Formal Request for an Interview**

**[0008]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can discuss this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0009]** Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

### **Claim Amendments**

**[0010]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1-4, 6-7, 10-11, 16-17, 19, 22-23, and 26 herein. Applicant amends claims to clarify the distinctions between claimed features and the cited art. Such amendments are made to expedite prosecution and to more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not

be construed as further limiting the claimed invention in response to the cited references.

## **SUBSTANTIVE MATTERS**

### **Claim Rejections under § 103**

[0011] Claims 1-7, 10-23, and 26 are rejected under 35 U.S.C. §103. In light of the amendments presented herein and the decisions/agreements reached during the above-discussed Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0012] For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

[0013] Accordingly, Applicant respectfully requests that the § 103 rejections be withdrawn and the case be passed along to issuance.

[0014] The Examiner's rejections are based upon the following references in varying combination:

- **Fenwick, Jr.:** *Fenwick, Jr., et al.*, US Patent Publication No. 2003/0204852 (Published October 30, 2003);
- **Freeman:** *Freeman, et al.*, US Patent Publication No. 2002/0129374 (Published September 12, 2002);
- **Heauvelman:** *Heauvelman*, US Patent Publication No. 2003/0126600 (Published July 3, 2003);
- **Lamkin:** *Lamkin, et al.*, US Patent Publication No. 2002/0088011 (Published July 4, 2002);

- **Dureau:** *Dureau*, US Patent Publication No. 2003/0135860 (Published July 17, 2003);
- **Eytchison:** *Eytchison*, US Patent No. 6,363,434 (issued March 26 2002); and
- **Harrison:** *Harrison, et al.*, US Patent No. 6,732,373 (issued May 4, 2004);

### **Overview of the Application**

[0015] The Application describes a technology for A DVD jukebox, or the like, that is integrated with a home network and serves as a centralized storage of multiple video/audio titles that can be selected and played on display devices, such as televisions, at different locations in the home. (Abstract)

### **Cited References**

[0016] The Examiner cites Fenwick, Jr. as the primary reference in the obviousness-based rejections. The Examiner cites Freeman and Heauvelman as secondary references in the obviousness-based rejections.

#### **Fenwick, Jr.**

[0017] Fenwick, Jr. describes a menuing system for a video distribution system that provides an interactive display to allow a user to select and control the delivery of program material. (Abstract)

Freeman

**[0018]** Freeman describes a technology for an interactive television system which utilizes various distribution networks for simultaneously providing a plurality of viewers with an interactive television program comprising a plurality of signals related in time and content. (Abstract)

Heuvelman

**[0019]** Heuvelman describes a technology for a content recommendation system that generates recommendations for new or upcoming content for a user while he/she may still consume a previous content. (Abstract)

Lamkin

**[0020]** Lamkin describes a method for providing enhanced content for play across multiple play platforms. (Abstract)

Dureau

**[0021]** Dureau describes a method and mechanism for configuring a receiver as a proxy to transcode data and provide for intercommunication among secondary devices. (Abstract)

Eytchison

**[0022]** Eytchison describes a method of managing resources within a network for consumer electronic media devices. In one of the disclosed embodiments, the method is implemented as a software resource manager

which provides a centralized resource allocation, reservation and access control functionalities for a home entertainment server. (Abstract)

Harrison

**[0023]** Harrison describes a host device that includes a processor and a control mechanism. The processor operates to receive primary and associated data, decode and separate the associated data from the primary data, and cause the associated data to be rendered on a separate hand held device. The processor also operates the control mechanism to control a separate display apparatus to separately receive and render the primary data. (Abstract)

## **OBVIOUSNESS REJECTIONS**

### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

[0024] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

### **Based upon Fenwick, Jr.**

[0025] The Examiner rejects claims 1-7, 10-23, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Fenwick, Jr. in varying combination with the above noted references. In particular, the Examiner has combined Fenwick, Jr. in combination with Freeman to reject all of the independent claims (claims 1, 11, and 17). Applicant respectfully traverses all of the claim rejections and asks the Examiner to withdraw the rejection of these claims and consider the claims anew.

### ***Independent Claim 1***

[0026] Applicant amends claim 1 herein. Applicant submits that the combination of Fenwick, Jr. and Freeman does not render this claim obvious because it does not teach at least the following elements as recited in this claim (with emphasis added):



- “establishing a two-way digital connection with a single playback device, ***the single playback device having a plurality of media types and titles stored therein, wherein at least one of the plurality of media types is a DVD*** containing a commercially available title”
- “retrieving contents of the selected title from the DVD in the single playback device”
- “transmitting the contents of the selected title to the media client for display on the display device”

**[0027]** The Examiner indicates (Action, p. 4-5) the following with regard to this claim:

Consider **claim 1**, FEHWICK teaches a computer-readable medium having computer-executable instructions for a media server residing on a home network to perform steps (SMS 10 -- Fig. 1; Paragraph 0016) comprising:

establishing a two-way digital connection with a jukebox, the jukebox having a plurality of DVD's containing available titles stored therein (Paragraph 0013 teaches an audiovisual device 8 -- Fig. 1, such as banks of digital video disk (DVD) players (jukebox) containing program materials such as on demand feature length and other films, video programs, etc that is connected to the SMS. Paragraph 0016 teaches two-way digital connection with the banks of digital video disk (DVD) players (jukebox));

querying the jukebox for information regarding titles stored on the DVD's in the jukebox (Paragraph 0020);

compiling and caching a title directory for the titles stored on the DVD's in the jukebox (Paragraph 0020);

receiving a request to use the jukebox from a media client on the home network (Paragraph 0024), the media client being connected to a display device (Paragraph 0015);

sending the title directory to the media client for presenting an interactive user interface on the display device (Paragraph 0027, 0030);

receiving a request from the media client for a selected title stored on a DVD in the jukebox (Paragraph 0040);

retrieving contents of the selected title from the DVD in the jukebox (Paragraph 0024, 0040); and

transmitting the contents of the selected title to the media client for display on the display device (Paragraph 0015, 0024, 0040).

FENWICK does not explicitly teach that DVD's containing commercially available titles.

In an analogous art FREEMAN teaches, DVD's containing commercially available titles (Paragraph 0029, 0260).

Therefore, it would have been obvious to a person of ordinary skill in the art to modify FENWICK's system to include DVD's containing commercially available titles, as taught by FREEMAN, for the advantage of providing viewers with a greater variety of widely distributed entertainment, such as different blockbusters, filmed/directed by professionals.

**[0028]** Applicant notes that the system of Fenwick, particularly the portion of Fenwick relied upon by the Examiner as teaching the claimed element (i.e. Fenwick's banks of DVD players), does not teach or suggest "a single playback device, the single playback device having a plurality of media types and titles stored therein, wherein at least one of the plurality of media types is a DVD..." as claimed.

**[0029]** In addition, Applicant notes that Freeman does not cure, and is not cited as curing this deficiency within Fenwick, Jr.

**[0030]** Because at least this claimed feature is not addressed in the rejection, the Examiner has not established a prima facie case of obviousness for this claim and its dependents.

**[0031]** Furthermore, Applicant submits that the Examiner has cited no reason from within the references themselves to combine the teachings of Fenwick, Jr. and Freeman.

**[0032]** The stated reasoning is "to include DVD's containing commercially available titles." Applicant submits that the system of Fenwick is not disadvantaged according to the stated reasoning. Fenwick, Jr. teaches a system and method that includes DVD media (by the Examiner's own admission) and provides access to such in the context of a hotel or motel "to provide their guests with video programming... [such] as feature length films" (Fenwick, 0004). Therefore the reasoning relied upon by the Examiner is fallacious. Such reasoning suggests the Examiner has used impermissible hindsight.

**[0033]** The above statement is draws on the reasoning of the BPAI presented in *Ex parte* Rinkevich (non-precedential decision) on May 29, 2007.

**[0034]** In its reasoning, the BPAI stated: "[a] factfinder should be aware, or course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning," (quoting KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also* Graham v. John Deere Co., 383 U.S. at 36, 148 USPQ at 474). In that case, as in the matter as issue here, the Applicant raised the issue of improper hindsight reasoning. Therein the BPAI was persuaded that the problem or deficiency that the Examiner raised as

motivation to seek out a secondary reference, “impermissibly used the instant claims as a guide or roadmap in formulating the rejection.” The BPAI further quoted the Supreme Court in *KSR* stating that “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it,” KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d at 1397. Applying common sense to the case at hand, the BPAI concluded that “a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill,” (emphasis provided). Ultimately the BPAI found that the Examiner had impermissibly used the claims as a guide to formulate the rejection.

**[0035]** As in *Ex parte Rinkevich*, Applicant submits one of ordinary skill in the art would have no reason to combine the teachings of Fenwick, Jr. with Freeman according to the Examiner’s stated reasoning, because Fenwick already addresses the need to supply commercially available DVD content and because neither reference expresses a reason to combine the teachings of these references, either explicitly or implicitly.

**[0036]** Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 2-7 and 10

[0037] These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim, which depends from an allowable base claim, is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

[0038] An exemplary dependent claim which may be allowable for additional independent reasons is dependent claim 3.

[0039] In rejecting this claim, the Examiner relies upon the combination of Fenwick, Freeman, Heuvelman, and Lamkin. In so doing, the Examiner states the following with regard to this claim:

Consider ~~claim 3~~, FENWICK, FREEMAN, and Heuvelman teach a title directory, containing information for a title stored on a DVD in the jukebox (FENWICK - Paragraph 0020), but do not explicitly teach a link to an Internet site containing information for a title stored on a DVD.

In an analogous art Lamkin teaches, a link to an Internet site containing information for a title stored on a DVD (Paragraph 0066 teaches external information weblinks for other information accessible through the Internet).

Therefore, it would have been obvious to a person of ordinary skill in the art to modify the system of FENWICK and Lamkin to include a link to an Internet site containing information for a title stored on a DVD, as taught by Lamkin, for the advantage of providing the user with the most up to date information about a title, and allowing external sources to continuously update and provide title information.

[0040] Lamkin teaches a method and apparatus for enhancing multimedia content with supplemental content. The disclosure however does not teach or suggest a "**title directory** includes a link to an Internet site" as is claimed in

claim 3. Applicant notes further that the combination of references without Lamkin, by the Examiner's own admission, fails to teach or suggest this feature.

**[0041]** Applicant submits therefore, that the Examiner has not established a prima facie case of obviousness for at least dependent claim 3. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Independent Claim 11*

**[0042]** Applicant amends independent claim 11 herein. Applicant submits that the combination of Fenwick, Jr. and Freeman does not render this claim obvious because it does not teach at least the following elements as recited in this claim:

- "transcribing the contents of the selected title from one security scheme to another"
- "displaying the transcribed contents of the selected title on the display device a display device"

**[0043]** The Examiner indicates (Action, p. 6-7) the following with regard to this claim:

Consider **claim 11**, FENWICK teaches a computer-readable medium having computer-executable instructions for a media client residing on a home network (Paragraph 0023, 0040) and connected to a display device (Paragraph 0015) to perform steps comprising:

presenting on the display device an option to use a jukebox for selection by the user (Paragraph 0031 teaches instructing the user to press a menu button, in order to access titles available at audiovisual devices such banks of digital video disk (DVD) players (jukebox) as taught in Paragraph 0013. The option to use the DVD players (jukebox) is the instruction to press a menu button, to access titles stored by the DVD players (jukebox)), the jukebox being connected to the home network via a media server (Fig. 1; Paragraph 0013-0014, 0015);

receiving a first user input signal selecting the option to use the jukebox (Paragraph 0031 teaches the user pressing a menu button, in order to access titles available at the banks of digital video disk (DVD) players (jukebox).  
*Thereby pressing the menu button, the user selects to use the DVD players (jukebox);*

querying the media server connected to the jukebox for information on DVD's containing available titles stored in the jukebox (Paragraph 0027, 0039);

receiving from the media server the information on titles stored on the DVD's in the jukebox (Paragraph 0027, 0039);

presenting an interactive user interface on the display device to present the information on the titles stored on the DVD's in the jukebox (Paragraph 0038);

receiving a second user input signal requesting viewing of a selected title stored on a DVD in the jukebox (Paragraph 0040);

requesting the media server for contents of the selected title (Paragraph 0024, 0040);

receiving the contents of the selected title from the media server (Paragraph 0024, 0040); and

displaying the contents of the selected title on a display device (Paragraph 0015, 0024, 0040).

FENWICK does not explicitly teach that DVD's containing commercially available titles.

In an analogous art FREEMAN teaches, DVD's containing commercially available titles (Paragraph 0029, 0203).

Therefore, it would have been obvious to a person of ordinary skill in the art to modify FENWICK's system to include DVD's containing commercially available titles, as taught by FREEMAN, for the advantage of providing viewers with a greater variety of widely distributed entertainment, such as different blockbusters, filmed/directed by professionals.

**[0044]** Applicant notes that the system of Fenwick does not teach or suggest transcribing as claimed.

**[0045]** Applicant additionally notes that Freeman does not cure, and is not cited as curing this deficiency within Fenwick, Jr.

**[0046]** Because at least this claimed feature is not addressed in the rejection, the Examiner has not established a prima facie case of obviousness for this claim and its dependents.

**[0047]** Furthermore, Applicant reiterates the above arguments made with regard to impermissible hindsight for this claim as well.



[0048] Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 12-16

[0049] These claims ultimately depend upon independent claim 11. As discussed above, claim 11 is allowable. It is axiomatic that any dependent claim, which depends from an allowable base claim, is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 17

[0050] Applicant amends claim 17 herein. Applicant submits that the combination of Fenwick, Jr. and Freeman does not render this claim obvious because it does not teach at least the following elements as recited in this claim (with emphasis added):

- "compile a title directory for the titles stored on the DVD's in the single playback device, wherein compiling the title directory comprises retrieving metadata associated with a title from a title server, the retrieving further comprising ***retrieving a predefined number of bits from the title server and using a hash of the predefined number of bits to identify the title on the title server***"

**[0051]** The Examiner indicates (Action, p. 8-9) the following with regard to this claim:

Consider **claim 17**, FENWICK teaches a home entertainment system (Fig. 1) comprising:

a home network (Fig. 1, Paragraph 0012);

a jukebox having a plurality of DVD's containing available titles stored therein (Paragraph 0013 teaches an audiovisual device 5 -- Fig. 1, such as banks of digital video disk (DVD) players (jukebox) containing program materials such as on demand feature length and other films, video programs, etc.);

a media server connected to the home network and having a two-way digital connection with the jukebox (SMS 10 -- Fig. 1; Paragraph 0013 teaches an audiovisual device 8 -- Fig. 1, such as banks of digital video disk (DVD) players (jukebox) connected to the SMS. Paragraph 0018 teaches two-way digital connection with the banks of digital video disk (DVD) players (jukebox));

a display device (Paragraph 0015); and

a media client connected to the display device and connected to the home network (RCS 14 -- Fig. 1, Paragraph 0015).

the media server being programmed to present the jukebox for discovery on the home network (Paragraph 0016), compile a title directory for the titles stored on the DVD's in the jukebox (Paragraph 0020), send the title directory to the media client (Paragraph 0027, 0038), retrieve contents of a selected title from the DVD in the jukebox, and transmit the contents of the selected title to the media client for display on the display device (Paragraph 0024, 0040), the media client being programmed to receive a user request to use the jukebox (Paragraph 0024), display an interactive user interface on the display device to present the title directory (Paragraph 0038), receive a user input signal selecting the selected title (Paragraph 0040), request the media server to send the contents of the selected title (Paragraph 0024, 0040), and display the contents of the selected title on the display device (Paragraph 0015, 0024, 0040).

FENWICK does not explicitly teach that DVD's containing commercially available titles.

In an analogous art FREEMAN teaches, DVD's containing commercially available titles (Paragraph 0029, 0033).

Therefore, it would have been obvious to a person of ordinary skill in the art to modify FENWICK's system to include DVD's containing commercially available titles, as taught by FREEMAN, for the advantage of providing viewers with a greater variety of widely distributed entertainment, such as different blockbusters, filmed/directed by professionals.

**[0052]** Applicant notes that during the interview of 7/30/08 the Examiner agreed that the cited art did not teach “using a hash” as claimed. Applicant appreciates same.

**[0053]** Furthermore, Applicant reiterates the earlier arguments regarding impermissible hindsight.

**[0054]** Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 18-23 and 26*

**[0055]** These claims ultimately depend upon independent claim 17. As discussed above, claim 17 is allowable. It is axiomatic that any dependent claim, which depends from an allowable base claim, is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**[0056]** An exemplary dependent claim which may be allowable for additional independent reasons is dependent claim 19.

**[0057]** In rejecting this claim, the Examiner relies upon the combination of Fenwick, Freeman, Heuvelman, and Lamkin.

**[0058]** Applicant submits that Freeman and Lamkin do not represent analogous art. Neither of these references is within the field of endeavor, and neither is particularly concerned with the problem addressed by the application.

**[0059]** Furthermore, Applicant reiterates arguments made in the communication filed 1/17/08 that it is improper to combine Heuvelman with Fenwick Jr. because there is no expectation of success.

**[0060]** This argument has not been addressed by the Examiner, yet the combination of references remains.

**[0061]** Applicant submits therefore, that the Examiner has not established a prima facie case of obviousness for at least dependent claim 19. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### **Dependent Claims**

**[0062]** In addition to its own merits, each dependent claim is allowable for at least the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

## **Conclusion**

[0063] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me or my assistant at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC  
Representatives for Applicant

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Dated: 08/25/08

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